

## **REMARKS**

Claims 1-8, 11-13, 16-30 and 33-40 were examined and reported in the Office Action. Claims 1-8, 11-13, 16-18, 20, 22-28, 33-35 and 40 are rejected. Claims 21 is canceled. Claim 1 is amended. Claims 1-2, 4-8, 11-13, 16-22, 24-30, and 33-40 remain.

Applicant requests reconsideration of the application in view of the following remarks.

### **I. Double Patenting**

It is asserted in the Office Action that claims 23, 24, 25, 26, 27, 28, 33, 34, 35 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,613,212 issued to Siebert et al. in view of Young et al. (5,290,587). Applicant has submitted a Terminal disclaimer complying with 37 CFR 3.73(b) for both of the aforementioned patents that were filed with the response dated March 10, 2005 to overcome the rejection. Applicant includes a copy of the terminal disclaimers previously filed, along with a copy of the returned postcard.

Accordingly, withdrawal of the obviousness-type double patenting rejection for claims 23, 24, 25, 26, 27, 28, 33, 34, 35 and 40 are respectfully requested.

### **II. 35 U.S.C. §102(a)**

It is asserted in the Office Action that claims 1-7, 11 and 12 are rejected under 35 U.S.C. §102(a) as being anticipated by JP 10-019846A issued to Shimadzu, ("Shimadzu"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

It is asserted in the Office Action that claim 21 would be allowable if rewritten in independent form including its base claim. Applicant has amended claim 1 to include the limitations of claim 21. Therefore, Applicant's amended claim 1 is allowable. Thus, the 35 U.S.C. §102(a) rejection is moot. Additionally, the claims that directly or indirectly depend on amended claim 1, namely claims 2-7, 11 and 12, are also allowable for the same reason.

**III. 35 U.S.C. §103(a)**

It is asserted in the Office Action that claims 8, 20 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shimadzu. Applicant respectfully traverses the aforementioned rejection for the following reasons.

Applicant's claims 8, 20 and 22 either directly or indirectly depend on claim 1. As mentioned above, it is asserted in the Office Action that claim 21 would be allowable if rewritten in independent form including its base claim. Applicant has amended claim 1 to include the limitations of claim 21. Therefore, since claims 8, 20 and 22 depend on Applicant's amended claim 1, the 35 U.S.C. §103(a) rejections for claims 8, 20 and 22 are moot.

**B.** It is asserted in the Office Action that claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over Shimadzu in view of the Derwant abstract of Hitachi (JP03092756A). Applicant respectfully traverses the aforementioned rejection for the following reasons.

Applicant's claim 13 directly depends on amended claim 1. Since Applicant's amended claim 1 is allowable for the reasons asserted in section II, Applicant's claim 13 is also allowable. Therefore, the 35 U.S.C. §103(a) rejection of claim 13 is moot.

**C.** It is asserted in the Office Action that claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Shimadzu in view of U. S. Patent No. 5,290,587 issued to Young ("Young 1") and U. S. Patent No. 5,240,585 issued to Young et al. ("Young II"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

Applicant's claim 16 depends on amended claim 1. Since Applicant's amended claim 1 is allowable for the reasons asserted in section II, Applicant's claim 13 is also allowable. Therefore, the 35 U.S.C. §103(a) rejection of claim 16 is moot.

**D.** It is asserted in the Office Action that claims 17 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shimadzu in view of Young 1 and Young II, as applied to claim 16 above, and further in view of U. S. Patent No. 6,054,032 issued to

Haddad et al. ("Haddad"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

Applicant's claims 17-18 depend on amended claim 1. Since Applicant's amended claim 1 is allowable for the reasons asserted in section II, Applicant's claims 17-18 are also allowable. Therefore, the 35 U.S.C. §103(a) rejections of claims 17-18 are moot.

#### **IV. Allowable Subject Matter**

Applicant notes with appreciation the Examiner's assertion that claims 19, 21, 29, 30, and 36-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has amended claim 1 to include the limitations of claim 21.

Applicant respectfully asserts that claims 1-8, 11-13, 16-30 and 33-40, as it now stands, are allowable for the reasons given above.

**CONCLUSION**


In view of the foregoing, it is believed that all claims now pending, namely 1-2, 4-8, 11-13, 16-22, 24-30, and 33-40, patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16, 1.17 or 1.20(d), particularly extension of time fees.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

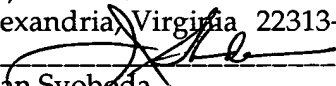
Dated: July 28, 2005

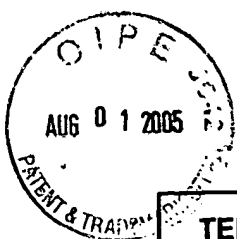
By   
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to: Mail Stop AF, Commissioner for Patents, Post Office Box 1450, Alexandria, Virginia, 22313-1450 on July 28, 2005.

  
Jean Svoboda



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## TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT

Docket Number (Optional)

15675P299X

In re the Application of: Rainer Siebert, et al.

Application No.: 09/632,573

Filed: August 04, 2000

For: IMPROVEMENTS TO MULTICAPILLARY ELECTROPHORESIS SYSTEMS - UTILITY - CIP

The owner\*, Centre National De La Recherche Scientifique of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,613,212. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

2. ☒ The undersigned is an attorney of record.

  
\_\_\_\_\_  
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3/10/2005

\_\_\_\_\_  
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